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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,393	12/23/1999	JAN STENSBORG	0459-0386P	7348
7590 04/06/2006				
BIRCH STEWART KOLASCH & BIRCH LLP PO BOX 747 FALLS CHURCH, VA 220400747			EXAMINER JACKSON, MONIQUE R	
			ART UNIT 1773	PAPER NUMBER
DATE MAILED: 04/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/471,393

Applicant(s)

STENSBORG ET AL.

Examiner

Monique R. Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 73,75-82,84-96,102-104 and 116-122 is/are pending in the application.
- 4a) Of the above claim(s) 91-96,102-104 and 116-122 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 73,75-82 and 84-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/26/06 has been entered.
2. The amendment filed 1/26/06 has been entered. Claims 97-100, 105-108, 110-113, 115 and 123-128 have been canceled. Claims 73, 75-82, 84-96, 102-104 and 116-122 are pending in the application. Note: The amendment recites "Claims 97-101" but does not include a claim identifier, however given the group listing and the format of the rest of the claims, the Examiner has assumed that claims 97-101 have been canceled.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 73, 75-82, and 84-90 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention. Claim 73 recites “A method for replicating a surface relief” however the last section of the claim now recites the step of “forming a sidewall part of a metal article from the metal substrate holding replicated surface relief” and though the Applicant has general support for a metal article having a sidewall formed from the replicated product, the original disclosure at the time of filing does not support this last step as part of the “method for replicating a surface relief”. In fact, this last section actually recites a process step that follows the method of replicating the surface relief as indicated by the term “from the metal substrate holding replicated surface relief”. Hence, in terms of the “method for replicated a surface relief”, the Examiner takes the position that the “forming a sidewall part” step must be referring to intended use of the replicated surface relief produced by the claimed process.

***Claim Rejections - 35 USC § 103***

6. Claims 73, 75-82, and 84-90 rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 297 764 (EP’764.) EP’764 teaches a method of making articles carrying reflective holograms wherein a resin layer on the order of 60 microns is provided on a metal substrate, such as aluminum sheet, that is to be formed into the final product and the holographic image is impressed into the coated metal substrate by a rolling or stamping process (Col. 1-2.) EP’764 further teach that the holographic image may be provided with a transparent protective coating of thermoplastic lacquer (Col. 2, lines 2-8.) Though EP’764 teach that a transparent coating layer or an opaque layer may be utilized as the layer to be embossed on the metal substrate, EP’764 does not teach that the metal substrate is first provided with a color layer below the embossed resin layer, however, as discussed in the previous office actions, the use of a holographic image in conjunction with an underlying color or print layer is well known in the art to enhance

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aesthetic properties of the article and would have been obvious to one having ordinary skill in the art at the time of the invention. Further, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide a metallized layer, such as a conventional aluminum layer, on the embossed image as is conventional in the hologram art and to determine the optimum thickness of the resin layer based on the desired embossed image wherein it is known in the art that the layer to be embossed must be of a sufficient thickness to hold the surface relief pattern. Lastly, though EP'764 specifically teaches that the metal substrate may be used to produce caps for containers, EP'764 does not specifically teach that the metal substrate with the holographic image is used to produce a sidewall of a container however considering it is known in the art that aluminum sheet having a holographic design may be used as a sidewall material in making containers such as beverage cans, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize the product taught by EP'764 to produce cans.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson  
Primary Examiner  
Technology Center 1700  
April 3, 2006